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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,053	09/12/2003	Olga Bandman	PF-0331-3 DIV	1993
27904	7590	01/11/2006	EXAMINER	
INCYTE CORPORATION EXPERIMENTAL STATION ROUTE 141 & HENRY CLAY ROAD BLDG. E336 WILMINGTON, DE 19880			FRONDA, CHRISTIAN L	
			ART UNIT	PAPER NUMBER
			1652	
DATE MAILED: 01/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/663,053	Applicant(s) BANDMAN ET AL.	
	Examiner Christian L. Fronda	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,9-12,17-20,23,26,27,31-34 and 56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1,2,9-12,17-20,23,26,27,31-34 and 56 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim(s) 1, 2, 17, 18, 56, drawn to a polypeptide, composition comprising said polypeptide, classified in class 530, subclass 350.
 - II. Claim(s) 9, 10, 12, drawn to an isolated polynucleotide and method of producing a polypeptide, classified in class 435, subclass 69.1.
 - III. Claim(s) 11, 31, 32, 34, drawn to antibodies, classified in class 530, subclass 387.1.
 - IV. Claim(s) 19, a method for treating a disease or condition associated with decreased expression of functional LCAP comprising administering to a patient a composition comprising a polypeptide and a pharmaceutically acceptable excipient, classified in class 514, subclass 2.
 - V. Claim(s) 20, drawn to a method of screening a compound for effectiveness as an agonist of a polypeptide, classified in class 435, subclass 7.1.
 - VI. Claim(s) 23, drawn to a method of screening a compound for effectiveness as an antagonist of a polypeptide, classified in class 435, subclass 7.1.
 - VII. Claim(s) 26, drawn to a method of screening for a compound that specifically binds to a polypeptide comprising combining the polypeptide with at least one test compound and detecting binding, classified in class 435, subclass 7.1.
 - VIII. Claim(s) 27, drawn to a method for screening for a compound that modulates activity of a polypeptide comprising combining the polypeptide with at least one test compound and assessing the activity of the polypeptide in the presence and absence of the test compound, classified in class 435, subclass 7.1.
 - IX. Claim(s) 33, drawn to a method of diagnosing a condition or disease associated with the expression of LCAP in a subject comprising administering an effective

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amount of a composition comprising an antibody, classified in class 424, subclass 130.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I –III are patentably distinct products because each of the products of Groups I -III are independent chemical entities that require different literature searches.

Polypeptides, which are composed of amino acids, and polynucleotides, which are composed of purine and pyrimidine units, are structurally distinct molecules. The protein of Group I and the antibody of Group III are structurally distinct molecules, where the protein of Group I is a large molecule which contains potentially hundreds of regions to which an antibody may bind and the antibody of Group III is defined in terms of its binding specificity to a small structure within the protein of Group I.

Inventions of Groups IV-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The processes of Groups IV-IX are distinct both physically and functionally; require different process steps, reagents, and parameters; and have different purposes.

Inventions of Groups II, III, and IV-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The processes of Groups IV-VIII do not require the products of Groups II and III.

Inventions of Groups I, II, and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The process of Group IX does not require the product of Group I and II.

Group I and Groups IV-VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as using the polypeptide in a process to make antibodies to the polypeptide.

Group III and Group IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as using the antibody in a protein purification process to separate and purify a polypeptide from a biological sample.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and classification, restriction for examination purposes as indicated is proper.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.


4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L Fronda whose telephone number is (571)272-0929. The examiner can normally be reached Monday-Friday between 9:00AM - 5:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura N Achutamurthy can be reached on (571)272-0928. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian L. Fronda
Patent Examiner
Art Unit 1652



Manjunath Rao
Primary Patent Examiner
Art Unit 1652